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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,111	09/08/2003	Francesco Salituro	VPI/98-11 DIV	9944
1473	7590	09/30/2004	EXAMINER	
FISH & NEAVE 1251 AVENUE OF THE AMERICAS 50TH FLOOR NEW YORK, NY 10020-1105			RAO, DEEPAK R	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/658,111	<b>Applicant(s)</b> SALITURO ET.AL.	
	<b>Examiner</b> Deepak Rao	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-33 ~~8~~ are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-33 ~~8~~ are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06212004</u> . | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

Claims 11-33 are pending in this application.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-33 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the treatment of arthritis, does not reasonably provide enablement for treating or preventing inflammatory diseases, infectious diseases, proliferative diseases, neurodegenerative diseases, autoimmune diseases, etc. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to the invention commensurate in scope with these claims. The reasons provided in the previous office action are incorporated here by reference.

In evaluating the enablement question, several factors are to be considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed. The determination that “undue experimentation” would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations.

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The scope of the claims is not adequately enabled solely based on the activity related to p38 inhibition activity provided in the specification. First, the instant claims cover 'diseases' that are known to exist and those that may be discovered in the future, for which there is no enablement provided. The use disclosed in the specification is as pharmaceutical therapeutic agents having p38 inhibitory activity, useful to treat a laundry list of diseases, which include inflammatory diseases, neurodegenerative disorders, autoimmune diseases, proliferative disorders, angiogenic disorders, etc. Test procedures and assays are provided in the specification at pages 34-42, however, none of the instantly claimed compounds have been tested for the disclosed activity. Further, there is nothing in the disclosure regarding how the *in vitro* test data correlates to the treatment of the diverse disorders embraced the instant claims. The disorders encompassed by the instant claims include neurodegenerative diseases, proliferative disorders, angiogenic disorders, etc., some of which have been proven to be extremely difficult to treat. There is no reasonable basis for assuming that the myriad of compounds embraced by the claims will all share the same physiological properties since they are so structurally dissimilar as to be chemically non-equivalent and there is no basis in the prior art for assuming the same. Note *In re Surrey*, 151 USPQ 724 regarding sufficiency of disclosure for a Markush group.

The state of the art reference, Laszlo et al., discloses a compound SB 203580 that is effective in cytokine inhibition and inflammatory diseases, was found to be not a very potent inhibitor of p38 kinase, see the discussion on pages 2692-3. The reference further relates inhibition of p38 kinase only to arthritis, see the last two lines on page 2693.

The claims are drawn to a method of treating a myriad of diseases with different etiologies such as inflammatory diseases, autoimmune diseases, proliferative diseases,

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neurodegenerative diseases, etc. It is inconceivable as to how the claimed single class of compounds can treat the laundry list of diseases recited in the claims having diverse mechanisms. Enablement for the scope of treating 'inflammatory diseases' generally is not present. For a compound or a genus to be effective against all inflammatory diseases is contrary to medical science. Inflammation is a process which can take place in virtually any site or any part of the body. There is no common mechanism by which all, or even most inflammatory diseases arise. Mediators include bradykinin, serotonin, histamine, leukotriene, cytokine, and many others. Accordingly, treatments for inflammatory diseases are normally tailored to the particular type of inflammation, and there is no "magic bullet" against inflammatory disease generally.

Further, 'neurodegenerative diseases' cover diverse disorders such as Alzheimer's disease, dementia, hereditary cerebellar ataxias, paraplegias, syringomyelia, phakomatoses, and much more. In fact, Layzer, Cecil Textbook of Medicine (article enclosed), states that, "some degenerative diseases are difficult to classify because they involve multiple anatomic locations" (see page 2050). For example, Alzheimer's disease has traditionally been very difficult or impossible to prevent or even to treat effectively with chemotherapeutic agents. See e.g., the Cecil Textbook of Medicine, 20th edition (1996), Vol. 2, wherein it is stated that "[t]here is no cure for Alzheimer's disease, and no drug tried so far can alter the progress of the disease." (pg. 1994).

There is no such agent which can treat 'infectious diseases' generally. The recitation is extremely broad. Some infectious diseases are caused by bacteria (e.g., meningitis, whooping cough, tetanus, syphilis, etc.), some are caused by virus (e.g., HIV, common cold, measles,

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chicken pox, etc.), some due to fungus (e.g., athlete's foot, etc.), some are caused by protozoa (e.g., amebiasis, giardiasis, leishmaniasis, etc.). Not only that the viral diseases different from bacterial or fungal diseases, but the viral diseases are also different one from the other. The nature of effect, origin, symptom, incubation, diagnosis, etc. is different for each one from the other. The same is true for other 'infectious diseases' embraced by the instant claims.

A 'proliferative disorder' is anything that causes abnormal tissue growth. That can be growth by cellular proliferation more rapidly than normal, or continued growth after the stimulus that initiated the new growth has ceased, or lack (partial or complete) of structural organization and/or coordination with surrounding tissue. It can be benign or malignant. Thus, such term covers not only all cancers, but also covers precancerous conditions such as lumps, lesions, polyps, etc. No compound has ever been found to cancers of all types generally. Since this assertion is contrary to what is known in medicine, proof must be provided that this revolutionary assertion has merits. The existence of such a "silver bullet" is contrary to our present understanding of oncology. Cecil Textbook of Medicine states that "each specific type has unique biologic and clinical features that must be appreciated for proper diagnosis, treatment and study" (see the enclosed article, page 1004). Different types of cancers affect different organs and have different methods of growth and harm to the body. Also see *In re Buting*, 163 USPQ 689 (CCPA 1969), wherein 'evidence involving a single compound and two types of cancer, was held insufficient to establish the utility of the claims directed to disparate types of cancers'. Thus, it is beyond the skill of oncologists today to get an agent to be effective against cancers generally.

The claims recite the use of the instantly claimed compounds in treating or preventing a angiogenic disorder. "Angiogenesis" is the process of vascularization of a tissue involving the development of new capillary blood vessels and therefore, is not seen as being a disease or disorder, but as an absolutely essential body process. Thus, there is no enablement for treating something which is not itself a problem and is indeed essential for life.

(Only a few of the claimed diseases are discussed here to make the point of an insufficient disclosure, it does not definitely mean that the other diseases meet the enablement requirements).

The instant claims recite 'treating or preventing', and therefore, the instant claim language embraces disorders not only for the treatment, but also for "prevention" which is not remotely enabled. Based on the *in vitro* test assays to measure the p38 kinase inhibitory activity, the instant claims are directed for the use of the compounds not only in the treatment but also in the "prevention" of a large list of diseases, for which applicants provide no competent evidence. "To prevent" actually means *to anticipate or counter in advance, to keep from happening etc.* (as per Webster's II Dictionary) and therefore it is not understood how one skilled in the art can reasonably establish the basis and the type of subject to which the instant compounds can be administered in order to have the 'preventive' effect. It is inconceivable how the *in vitro* test procedures can be correlated to the 'treatment and prevention' of the various claimed disorders, such that the claimed compounds can not only treat but also "prevent" a myriad of diseases associated with the stated activity. Further, there is no evidence on record which demonstrates that the *in-vitro* screening test relied upon is recognized in the art as being reasonably predictive of success in any of the contemplated areas of 'prevention'. Such a reasonable correlation is

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necessary to demonstrate such utilities. See *Ex parte Stevens*, 16 USPQ 2d 1379 (BPAI 1990); *Ex parte Busse et al.*, 1 USPQ 2d 1908 (BPAI 1986) (the evidence must be accepted as "showing" such utility, and not "warranting further study").

Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the use of the invention. In view of the breadth of the claim, the chemical nature of the invention, the unpredictability of ligand-receptor interactions in general, and the lack of working examples regarding the activity of the claimed compounds, one having ordinary skill in the art would have to undergo an undue amount of experimentation to use the invention commensurate in scope with the claims.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11, 14 and 20-40 of



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copending Application No. 10/365,719 (Pub No. 2004/0044002). Although the conflicting claims are not identical, they are not patentably distinct from each other because there is a significant overlap between the instantly claimed genus and the genus of the reference claims. See formula (Ia) of claim 1 and the compounds disclosed in Table 3. The instant claims differ by reciting a more limited subgenus than the reference. It would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as taught for the genus as a whole i.e., as pharmaceutical therapeutic agents. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Receipt is acknowledged of the Information Disclosure Statement filed on June 21, 2004 and a copy is enclosed herewith.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (571) 262-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting-SPE of 1624 at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Deepak Rao**  
**Primary Examiner**  
**Art Unit 1624**

September 27, 2004